REMARKS

Claims 1-2, 5-7, 9, 34-35, 42, 46, 50, 54 and 58-66 are pending. Claims 58 and 64 have been withdrawn from consideration by the Examiner. Applicant has cancelled claim 63. Applicant has newly amended Claim 1 by removing the recitation in step (a) of the phrase "dendritic cells which are autologous with respect to said patient". Applicant has amended Claim 34 by removing the recitation of the phrase "of step (a)". No new matter has been entered.

Claims rejection - 35 U.S.C. § 112, second paragraph

Claims 34 and 63 are rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 63 has been cancelled, rendering its rejection moot.

Claim 34 has been amended to omit the recitation of the phrase "of step (a)", thereby obviating the lack of antecedent basis.

Reconsideration and withdrawal of the above ground of rejection is respectfully requested.

Claims rejection - 35 U.S.C. § 112, first paragraph – written description/new matter

Claims 1, 2, 5-7, 9, 34, 35, 42, 46, 50, 54, 59-63, 65, and 66 stand/are rejected under 35 U.S.C. § 112, first paragraph as containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) had possession of the claimed invention at the time that the application was filed.

The office action indicates that the specification and claims as originally filed do not provide support for:

(A) the method of Claim 1 comprising producing a plurality of DC/tumor cell hybrids:

a) for "a reduction of the number of tumor cells in a patient",

b) comprising the "allogeneic" DCs of step (a),

c) comprising the allogeneic tumor cell characteristic of the dame cancer type with respect to said patient" of step (b),

d) comprising selecting hybrids "that exhibit DC markers, TAAs and the capacity to activate naive T cells in vitro that can recognize the cancer cells of step (b)".

B) The method of claim 9 comprising producing a fused cell product "using PEG" and

C) The method of claim 34 comprising tumor cells …sensitive to a drug.

D) The method of claim 59, comprising "a tumor cell line having at least one TAA in common with said tumor sample".

E) The method of claim 66.

Regarding point A), a), The Examiner acknowledges that original claim 1 did recite the limitation necessitating the rejection set forth above. In noting that claim 1 is not original to parent applications 09/951,849 ('849) nor 09/049,502 ('502), of which the instant application claims to be a divisional application and a continuation application respectively, the Examiner contends that the limitations of the claim must find support in the specification common to the three applications.

However, Applicant respectfully disagrees. MPEP 2163.06 states:

> "The claims as filed in the original specification are part of the disclosure and therefore, if an application as originally filed contains a claim disclosing material not disclosed in the remainder of the specification, the applicant may amend the specification to include the claimed subject matter. *In re Benno*, 768 F.2d 1340, 226 USPQ 683 (Fed. Cir. 1985)".

Further MPEP 608.04(b) states:

> "For applications filed prior to September 21, 2004, a preliminary amendment that was present on the filing date of an application may be considered a part of the original disclosure if it was referred to in a first filed oath or declaration in compliance with 37 CFR **1.63**."
> "Applicants can avoid the need to file an oath or declaration referring to any preliminary amendment by incorporating any desired amendments into the text of the specification including a new set of claims when filing the application instead of filing a preliminary amendment, even where the application is a continuation or divisional application of a prior-filed application", emphasis added.

The instant application meets the filing requirement of MPEP 608.04(b) being filed on February 7, 2002. The oath/declaration filed on February 7, 2002 makes reference to the preliminary amendment filed February 2, 2002. Applicant notes that MPEP 2163 states nothing about claims of parent applications, stating only that the claims as filed in the original specification are part of the disclosure, while MPEP 608.04 specifically refers to claims added in a divisional or continuation, being part of the specification of the continuation or divisional application.

Thus, according to both MPEP 2163 and MPEP 608.04, claims originally filed with an application may be considered part of the specification. Accordingly, claims 1-57 as filed on the

filing date (February 2, 2002) of the instant application, may be considered part of the instant specification. Therefore, the content of these 57 claims as originally filed is not new matter.

Originally filed claim 1 recites:

> 1. A method for producing a plurality of dendritic cell/tumor cell hybrids which induce an anti-tumor response when applied to a patient causing a reduction of the number of tumor cells in said patient, said method comprising: (a) providing a sample of a tumor against which said response is needed, (b) preparing a primary cell culture comprising tumor cells derived from said tumor sample, (c) providing autologous or HLA-compatible allogeneic dendritic cells, and, (d) fusing said dendritic cells with said tumor cells to produce a plurality of hybrids.

Further support for pending claim 1 can be found as follows:

Basis for the preamble of claim 1 "**A method for producing a plurality of dendritic cell/tumor cell hybrids which induce an anti-tumor response when applied to a patient**...", may be found in claim 1 of '425 as originally filed; in claim 9 of '849 as originally filed; and in claim 9 of '502 as originally filed.

Basis for the recitation of the phrase "**causing a reduction of the number of tumor cells in said patient**" in instant claim 1 may be found in claim 1 of '425 as originally filed, and in the specification on page 60, paragraphs 1 and 2. These paragraphs disclose that injections of the hybrid cells 'prevented the growth of the pre-established P815 mastcytoma and provided long term protection'. When mice were inoculated with a lethal dose of P815 and subsequently received intraperitoneal injections of hybrid cells, long term protection resulted in 55% of the animals (see Figure 12). In untreated animals, the tumors grew and killed the animals. The treated mice were also protected against a second tumor challenge (p.60-61, bridging paragraph; Figure 13). More generic descriptive support is found on page 15, second full paragraph, of the present specification which discloses that 'the term 'activation of immune cells in vivo' which refers to the immune rejection of a residual tumor, as measured by its reduction in size and by the survival of the patient, as shown for mice in Example 5C or Example 12. In Example 10 (in particular on page 49), it is shown that the human DC/TC hybridoma expresses T-cell activating molecules illustrating their immunogenic potential.

Basis for the recitation of the phrase in "**said method comprising**: **(a)providing dendritic cells, wherein said dendritic cells are selected from the group consisting of: dendritic cells which are allogeneic with respect to said patient, and dendritic cells which are both allogeneic with respect to said patient and HLA compatible with said patient, and,"** may be found in claim 1 of '425 as originally filed; in claim 9 of '849 as originally filed;

and in claim 9 of '502 as originally filed: specifically the recitation "providing autologous or HLA-compatible allogeneic dendritic cells".

This claim is supported generally at page 28, lines 20-27 (Embodiments A & B) of '425, '849 and '502. Preparation of tumor cells is described generally at page 23, line 3 to page 25, line 12, of '425, '849 and '502. The use of autologous or HLA-compatible DCs is described at page 10, paragraph 3 of '425, '849 and '502.

That DCs may be taken from a healthy HLA-compatible donor is also disclosed for instance on page 25, lines 13-18 of '425, '849 and '502. Figure 11 further illustrates that hybrid cells sensitize allogeneic naïve T-lymphocytes (page 20, lines 15-16 of '425, '849 and '502). This indicates that for the tumor removal DC and TC cells may be autologous to each other but may also be allogeneic or allogeneic and HLA compatible.

Basis for the recitation in instant claim 1 of the phrase "**wherein said dendritic cells are either isolated from bone marrow, lymph or blood, or are differentiated in vitro from dendritic cell precursors isolated from bone marrow, lymph or blood, and,...**" may be found for instance, on page 25, lines 13-25 of the '425, '849 and '502 applications as originally filed.

Basis for the recitation in instant claim 1 of the phrase **"(b) fusing said dendritic cells with tumor cells to produce a plurality of dendritic cell/tumor cell hybrids,"** may be found in claim 1 of '425 as originally filed; in claim 9 of '849 as originally filed; and in claim 9 of '502 as originally filed.

Basis for the recitation in instant claim 1 of the phrase **"wherein said dendritic cell is not a T-lymphocyte or B-lymphocyte,"** may be found on page 4, lines 7-8, page 4, lines 11-15 and page 11, lines 23-26 of '425 (and thus also of '849 and '502) where the DCs are defined as part of the DLC cell population.

Basis for the recitation in instant claim 1 of the phrase "**wherein said tumor cell is selected from the group consisting of : an autologous tumor cell with respect to said patient, and an allogeneic tumor cell characteristic of the same cancer type with respect to said patient**," may be found in claim 1 of '425 as originally filed; in claim 9 of '849 as originally filed; and in claim 9 of '502 as originally filed: e.g., 'a sample of a tumor against which said response is needed'. That tumor cells with at least one of the tumor-associated antigens from the patient's tumor cells may be used is mentioned on for instance page 25, lines 9-12 of '425, '849 and '502. Applicant also refers to claim 59 discussed below.

Basis for the recitation in instant claim 1 of the phrase **"(c) selecting from said plurality of dendritic cell/tumor cell hybrids that exhibit dendritic cell markers, tumor associated antigens and the capacity to activate naïve T cell in vitro that can recognize the cancer cells of (b)**", may be found in for example claims 10 and 11 of '425 as originally filed; in claims 19 and 20 of '849 as originally filed and in claims 19 and 20 of '502: originally filed. That naïve T cells are activated by the hybrid cells is mentioned for example, on page 59, lines 13-20 of the '425, '849 and '502 applications as originally filed.

In view of originally filed claim 1's constituting proper support for instant claim 1, and in view of the Examiner's acknowledgement that "original claim 1 did recite the limitation necessitating the rejection" pages 8-9 of office action dated May 22, 2008, referring to the limitation of causing a reduction of the number of tumor cells in the patient, and in view of its support in the specification, Applicant respectfully requests withdrawal of the new matter rejection of instant claim 1.

(B) Support for the claimed methods of producing a fused cell product "using PEG" as recited in pending claim 9 is found in the claims as originally filed and throughout the specification. As discussed above, claims 1-57 as filed on the filing date (February 2, 2002) of the instant application, may be considered part of the instant specification.
Therefore support for the recitation of instant claim 9, "**The method of claim 1, wherein said fusing is carried out using PEG**, is found in originally filed claim 9 which recites 'The method of claim 1 wherein the fusion in step (d) is carried out using PEG'. Originally filed claim 1 is drawn to a method for producing a plurality of dendritic cell/tumor cell hybrids, with step (d) reciting: 'fusing said dendritic cells with said tumor cells to produce a plurality of hybrids'. Further support for fusion using PEG (claim 9) is found throughout the Examples disclosed in the instant specification. See Example 3 (page 33, line 23), Example 9 (page 46, lines 21-25) and Example 12 (page 54, line 5). Applicant notes that the use of PEG to promote cell fusion is well known and is widely used in the art. One of ordinary skill in the art would know that the use of PEG to promote cell fusion is widely applicable to virtually all cell types and not limited to the specific conditions of Examples 3, 9 and 12.

(C) Support for the "**method of claim 1, wherein said tumor cells of step (a) are sensitive to a drug, said method further comprising, after step (c), killing unfused tumor cells by exposure to said drug**" as recited in pending claim 34, is found in the claims as originally filed and throughout the specification. Specifically, basis may be found for instance, in claim 34 of '425 as originally filed; in claim 31 of '849 as original filed; and in claim 22 of '502 as originally filed.

Further support for pending claim 34 is found on page 54, lines 9-12, of the instant specification which teaches that fused cells were resuspended in selection medium containing HAT. The instant specification further indicates that the parental 6-thioguanine -resistant P815 cells died in HAT medium (page 52, line 30 to page 53, line 6). Example 7 also describes the preparation of human HAT-sensitive tumor cell lines. The description also indicates that conditions are used so that only hybrid cells survived (see for instance page 34, lines 11-13 of '425, 849 and 502).

(D) Support for the " **method of claim 1, wherein the tumor cells of step (b) are from a tumor cell line having at least one tumor associated antigen in common with said tumor sample**" as recited in pending claim 59, is found throughout the specification. The tumor cell line will present at least one tumor associated antigen in common to the tumor sample to which an anti-tumor response is aimed at. If not, one skilled in the art knows that no anti-tumor response towards said tumor sample will be obtained. The specification further discloses that the term 'tumor-associated antigen' refers to a peptide derived from a protein expressed by a tumor cell (or cell line) which, when expressed by the hybridoma of the invention, will enable the hybridoma to elicit a tumor-specific response in vivo and/or in vitro (page 15, lines 3-7 of the '425, 849 and 502 applications as originally filed). Page 63, lines 14-15 of the '425, 849 and 502 specifications indicates that hybrid cells may express tumor-associated antigens. Hybrid cells have the capacity to process and present exogenous antigen (page 59, lines 8-9 of the '425, 849 and 502 applications).

E) Support for the "**method of claim 1, wherein said tumor cell is an allogeneic tumor cell with respect to said patient, and has one or more tumor associated antigens in common with that of said autologous tumor cell**", as recited in pending claim 65 is found generally in the instant specification on page 29, line 26 to page 30, line 13 (Embodiments J to M). Patient's

related pre-established immortal tumor cells are fused with DCs to yield DC/tumor cell hybridomas. In these embodiments, hybridomas with DC characteristics and expressing in addition the patient's matched tumor-associated antigen(s) may be selected for further use. Page 63, lines 14-15 of the '425, 849 and 502 specifications indicates that hybrid cells may express tumor-associated antigens. Hybrid cells have the capacity to process and present exogenous antigen (page 59, lines 8-9 of the '425, 849 and 502 specifications).

F) Support for the "**method of claim 1, wherein said anti-tumor response comprises the in vivo induction of immune effectors that confer resistance to a subsequent challenge with tumor cells**", as recited in pending claim 66, is found throughout the specification. The instant specification discloses that the term 'anti-tumor response in vivo' refers to the in vivo induction of immune effectors that confer resistance to a subsequent challenge with tumor cells, contribute to the rejection of pre-existing tumor cells and/or prevent or reduce the growth of tumors made of said tumor cells (see for instance page 12, line 31 to page 13, line 4 of the '425, 849 and 502 specifications as originally filed). In human subjects, appropriate non-invasive non-invasive measures can be used for demonstrating the presence of anti-tumor immune effectors. In Example 12 of the instant specification, the immune effectors include the generation and proliferation of cells displaying cytotoxic activity to tumor cells as well as the development of IL-2 secreting cells (page 13, lines 7-15 of the '425, 849 and 502 applications as originally filed).

In light of the above claim amendments and remarks, Applicant respectfully requests reconsideration and withdrawal of the instant rejections.

Rejection under 35 U.S.C. § 103(a)

Claims 1, 5-7, 9, 34, 35, 50, 54, 59-63, 65 and 66 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Guo et al. (1994) in view of Sornasse et al. (1992) and Young, et al. (1990).

Graham v. John Deere Co., 338 U.S. 1, 148 USPQ 459 (1966), recently reaffirmed by *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 82 USPQ2d 1385 (2007) provides the analytical framework for determining obviousness. Under Graham, obviousness is a question of law based on underlying factual inquires that address (1) the scope and content of the prior art, (2) the differences between the claimed invention and the prior art, and (3) the level of ordinary

skill in the pertinent art. Evidence of secondary factors (e.g., commercial success, long-felt but unmet need, and unexpected results) are also given weight in the analysis. Moreover, to establish a prima facie obviousness rejection of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Applicant respectfully traverses on the grounds that the cited references either alone or together, do not teach all the limitations of the claims as newly amended. The method for producing a plurality of dendritic cell/tumor cell hybrids which induce an anti-tumor response when applied to a patient, as recited in Claim 1 has been amended so that it no longer encompasses DC/tumor hybrids comprising dendritic cells that are autologous with respect to the patient.

Guo et al teaches a method of making a hybrid comprising tumor cells from Wistar rats and B cells from these rats, and using the hybrids as an immunogen in Wistar rats. Specifically, Guo et al. teach a method of fusing hepatocellular carcinoma derived from Wistar cells with activated B cells from Wistar rats to produce a hybrid which acted as an immunogen when injected into Wistar rats. However, Guo does not teach a method of producing and selecting such hybrids for use in non syngeneic rats.

Nor does Sornasse et al.'s (1992) data showing the effectiveness in antigen presentation of syngeneic dendritic cells in which antigen has been exogenously loaded onto their cell surface and/or Young, et al.'s (1990) teaching of methods to isolate dendritic cells, make up this difference. Specifically, Sornasse et al. does not specifically address the ability of dendritic cells to activate naïve T cells in a host which is not syngeneic with the dendritic cells. Nor does Young's teaching of isolating DCs from human PBMCs address the ability of dendritic cells to activate naïve T cells in a host which is not syngeneic with the dendritic cells.

Because the cited references, either in combination or individually, do not teach all the limitations of the claims as newly amended, specifically the limitation that the dendritic cells of the recited hybrids be allogeneic with respect to a patient, or be both allogeneic with respect to said patient and HLA compatible with said patient, a prima facie obviousness has not been established as required by *In re Royka*.

Any determination of obviousness also requires basis, such as, for example, some teaching, suggestion, or motivation in the prior art that would have led the skilled artisan to modify or combine prior art references to arrive at a claimed invention. See MPEP § 2143.

Further, a determination of obviousness must be made based on what a person of ordinary skill in the pertinent art would have known at the time of filing.

It is Applicant's position that it would not have been obvious to one of skill at the time of the invention to have substituted a dendritic cell for a B cell in a method of making the hybrid fusions encompassed by the instant claims.

Guo et al. (1994) teaches that activated B cells are the most efficient antigen presenting cell, citing a 1990 review article. So what motivation would provide one of skill at the time of the invention who was making a hybrid of antigen presenting cells and tumor cells, the incentive to substitute dendritic cells for the efficeint antigen presenting B cells taught by Guo?

Sornasse et al. teach that "Little is known about the induction by DC of specific B cell responses in vivo". Sornasse et al.'s experiments, designed to develop an immunization procedure avoiding the use of external adjuvant, all involve B and dendritic cells which have been exogenously pulsed with antigen before administration to the animal. That is the B cells and DC cells used by Sornasse et al. have been incubated with external antigen and subsequently administered to the subject.

In contrast, the fusions of the instant invention are not exogenously pulsed with antigen, and depend on their internal processing of tumor antigens within the cell to reach the cell surface in the context with cell surface antigen presenting molecules. Thus, Sornasse's conclusion, of "our data emphasizes the main role of DCs in initiating primary responses in vivo", as cited by the Examiner, is based on experiments where the antigen is artificially added to the dendritic cells before administration. These experiments did not specifically address the ability of dendritic cells initiate a primary response in vivo by internally processing and presenting antigens on its surface as required by the hybrids of the instant claims.

Considering that state of the art at the time of the invention, as described on the first page of the reference by Sornasse et al., was that "the capacity of the DC population to process and present proteins was down regulated when the dendritic cells matured in culture", page 15, column 2, one of skill in the art would have been disuaded from producing DC/tumor cell hybrids due to their probable lack of effectively proccessing their internal tumor antigens and presenting them on their cell surfaces after culturing. This teaching away is inconsistent with the use of the teachings of Sornasse et al. as motivation to substitute DC for B cells to provide antigen presenting functions in the tumor hybrids. MPEP § 2145(X)(D)(2) and the case law indicate that it is improper to combine references for purposes of an obviousness rejection,

where one reference teaches away from their combination. See, for example, In re Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983) "It is improper to combine references where the references teach away from their combination"; Winner International Royalty Corp. v. Wang, 202 F.3d 1340, 53 USPQ2d 1580 (Fed. Cir. 2000) "if Johnson did in fact teach away from Moore, then that finding alone can defeat Wang's obviousness claim"; and Tec Air, Inc. v. Denso Manufacturing Michigan Inc., 192 F.3d 1353, 52 USPQ2d 1294 (Fed. Cir. 1999) "there is no suggestion to combine, however, if a reference teaches away from its combination with another source".

In view of the claim amendments and comments, Applicant respectfully requests reconsideration and withdrawal of the rejection of the instant claims.

Rejection under 35 U.S.C. § 103(a)

Claims 2, 42, and 46 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Guo, et al. (1994) in view of Sornasse, et al. (1992) and Young, et al. (1990) as applied to Claims 1, 5-7, 9, 34, 35, 50, 54, 59-63, 65 and 66 above, and further in view of US Patent No. 5,851,756.

Applicant respectfully traverses on the grounds that the cited references either alone or together, do not teach all the limitations of the claims as newly amended.

The method for producing a plurality of dendritic cell/tumor cell hybrids which induce an anti-tumor response when applied to a patient as recited in Claim 1, has been amended so that it no longer recites the limitation that the dendritic cells used to produce the hybrids be autologous with respect to the patient. Dependent claims 2, 42 and 46 further comprise an induction step.

U.S. patent 5,851,756 was cited by the Examiner to show the use of GM-CSF in inducing DC characteristics. Since the teaching of the cited patent, either alone or in combination with the other cited references, does not teach a method for producing a plurality of dendritic cell/tumor cell hybrids which induce an anti-tumor response when applied to a patient, and which comprise dendritic cells which are allogeneic with respect to the patient, or which are both allogeneic with respect to said patient and HLA compatible with said patient, as required by the claims as newly amended, Applicant contends a prima facie case of obviousness has not been achieved. Reconsideration and withdrawal of the rejection is respectfully requested.

Rejection under 35 U.S.C. § 103(a)

Claims 50 and 54 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Guo, et al. (1994) in view of Sornasse, et al. (1992) and Young, et al. (1990) as applied to Claims 1, 5-7, 9, 34, 35, 50, 54, 59-63 and 66 above, and further in view of US 5,637,483.

U.S. patent 5,637,483 was cited by the Examiner to show the use of irradiation of tumor cells in an anti-tumor vaccine to prevent proliferation of the tumor cells in the patient. Irradiation of tumor cells was known at the time of the claimed invention.

Since the teaching of the cited patent, either alone or in combination with the other cited references, does not teach a method for producing a plurality of dendritic cell/tumor cell hybrids which induce an anti-tumor response when applied to a patient, and which comprise dendritic cells which are allogeneic with respect to the patient, or which are both allogeneic with respect to said patient and HLA compatible with said patient, as required by the claims as newly amended, Applicant contends a prima facie case of obviousness has not been achieved. Reconsideration and withdrawal of the rejection is respectfully requested.

Claims Rejection - 35 U.S.C. 102(b)

Claims 1, 7, 9, 10, 59, 60 and 66 stand/are rejected under 35 U.S.C. § 102 (b) as being clearly anticipated by Breel et al.

Applicant respectfully traverse the rejection of the instant claims, on the grounds that the hybrids produced by the methods taught by Breel et al. do not meet all the limitations of the dendritic cell/tumor cell hybrids produced by the instantly claimed methods. Specifically, Breel et al. teach the generation of hybrid cell lines in a fully syngeneic setting by fusion of SP2/0) myeloma cells (Balb/C origin) with a lymh node population enriched for DC (also from Balb/C origin), see page 170.

The hybrid cells were selected for their expression of the dendritic cell surface NLDC-145 marker. The selection resulted in the generation of four hybrid cell lines that express the antigen NLDC-145, although they do not show the typical morphology of DC. These hybrids when pulsed with exogenous antigen (KLH), were able to present this nontumor antigen to KLH primed T cells from a syngeneic source (Balb/C mice), see Figure 2 and the Materials and Methods section.

Accordingly, the fully syngeneic system of Breel et al. is inconsistent with a method for producing a plurality of dendritic cell/tumor cell hybrids which induce an anti-tumor response when applied to a patient, where the hybrids comprise dendritic cells which are *allogeneic* with respect to the patient, or which are both *allogeneic* with respect to said patient and HLA compatible with said patient, as required by the claims as newly amended.

In light of the above amendments and remarks demonstrating that the methods taught by Breel et al. produce hybrids that are patentably distinct from the hybrids produced by the instantly claimed methods, Applicant submits that Breel et al. is not an anticipatory reference. Accordingly, Applicants respectfully request reconsideration and withdrawal of the instant rejection.

CONCLUSION

In view of Applicants' amendments to the claims and the foregoing Remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Respectfully submitted,

Date: September 22, 2008

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